

## REMARKS

Applicant has not amended allowable claims 1-4. Claim 5 has been amended to include the limitations of original claim 8. Claim 8 is canceled. Claims 6, 7 now depend from an allowable claim, and the §102 and §103 rejections should be rendered moot.

Claim 9 now depends from allowable claim 5, and should maintain its allowability.

Claim 10 has been amended to include the limitations of original claim 5, and it has been further narrowed to describe the filter as located downstream from the raised ribs. This limitation clearly distinguishes Adams who discloses a filter housed in a shroud that has an air passage. No suggestion exists in the references to provide raised ribs apart from a filter, said raised ribs intrinsically directing an air flow in a circular path downstream to the filter.

Claim 14 is new and further narrows the limitations of the raised ribs according to the specification at page 24.

Claim 11 has been narrowed to define the fastener to distinguish Green, wherein Green's fastener means is a separate inner ring screwed into the hub. The inner ring then having a bolt threaded through the inner ring against the outer ring which has a Z shaped cross section. Green discloses his fastener bolt indirectly fastened to the hub via his inner ring. Applicant's design is simpler and less expensive and, therefore, non-obvious.

Claims 12, 13 now depend from an arguably allowable claim 11 and should be allowable.

Claim 14 is new and further narrows claim 10 as noted above.

Claim 15 is new and contains the limitations of original claims 11, 13 with the added limitation of placing the filter downstream from the raised ribs. This distinguishes Adams and should defeat the Examiner's §103 rejection since a new feature and benefit is now claimed with raised ribs circulating air downstream into a filter.

Claim 16 is new and it further narrows the definition of the raised ribs.

Claim 17 is new and it adds a limitation to an allowable claim, and should be allowable.

### **LAW OF OBVIOUSNESS**

It is well known that most inventions are composed of elements that *per se* are old and well known. That however, does not make an invention “obvious” under 35 U.S.C. 103. The Examiner’s attention is respectfully drawn to, for example, *ACS Hospital Systems, Inc. v. Montefiore Hospital et al.*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984), wherein the Court held that “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed combination, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.”

Also, as stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 1553, 220 USPQ 303 (Fed. Cir. 1983):

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Finally, even if all the constituents of an invention may be old, if the result would not have been obvious at the time the invention was made to a person having ordinary skill in the art, then the result may be patentable. *Reiner v. I. Leon Co.*, 285 F.2d 501, 503-504, 128 USPQ 25, (2d Cir. 1960).

In order to determine the basis for the rejection, the Examiner must:

- 1). Determine the scope and contents of the prior art;
- 2). Ascertain the differences between the prior art and the claims in issue;
- 3). Resolve the level of ordinary skill in the pertinent art; and
- 4). Evaluate evidence of secondary considerations.

Other basic considerations include:

- 1). The claimed invention must be considered as a whole;

- 2). The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- 3). The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- 4). Reasonable expectation of success is the standard with which obviousness is determined.

Finally, to sustain a *prima facie* case of obviousness:

- 1). There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2). There must be a reasonable expectation of success; and
- 3). The prior art reference must teach or suggest all the claim limitations.

The Examiner fails to meet the requirements to sustain an obviousness rejection based on these references.

### **LAW OF ANTICIPATION**

Section 102 (e) provides:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent....

A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described, in a single prior art reference. See: *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed Cir. 1987), *Structural Rubber Prods. CO. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270, (Fed. Cir. 1984), *Connell*, 722 F.2d at 1548, 220 USPQ at 198; *Kalman v. Kimberly-Clark Corp.*, 713 F2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026, 104 S. Ct. 1284, 79 L. Ed.2d 687 (1984).

Applicant respectfully requests the Examiner to pass this application to allowance on all pending claims.

Date: \_\_\_\_\_

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Respectfully submitted,



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